

#### REMARKS/ARGUMENTS

Claims 1-34 are currently pending in the application. Claims 1-5, 8, 12, 14, 15, 18 and 25-27 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publ. No. 2004/0198220 to Whelan et al. Claims 30-33 have been rejected under 35 U.S.C. § 103(a)1 as allegedly being unpatentable over U.S. Patent Publ. No. 2003/0139197 to Kostic et al. Claims 6, 9, 11, 16, 19 and 28 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Whelan in view of Kostic. Claims 7, 17 & 29 have also been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Whelan in view of U.S. Patent Publ. No. 2004/0103194 to Islam et al. Claims 10 and 20-24 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Whelan in view of Islam and Kostic. Claim 13 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Whelan in view of U.S. Patent No. 7,025,209 to Hawkins et al. Lastly, claim 34 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kostic in view of Whelan.

As a preliminary matter, applicants submit herewith an Information Disclosure Statement including additional references.

Applicants have amended claims 1, 12 and 25 to state that the association request received from clients includes "a list of one or more wireless network access devices detected by the wireless client during a scan," and that the association response "identifies

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<sup>1</sup> Applicants are somewhat unsure as to whether the Examiner intended to reject claims 30-33 under 35 U.S.C. 103(a) or 35 U.S.C. 102(e), since the rejection is set forth under the heading "Claim Rejections – 35 U.S.C. § 102" and includes no discussion of subject matter missing from the teachings of Kostic. Applicants will address the rejection under both statutory sections for sake of completeness.

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at least one of the wireless network access devices common to both the list of one or more wireless network access devices detected by the remote client element during a scan and the computed set of allowable wireless network access devices." Applicants have also amended claim 30 to state that a wireless client performs the recited steps. Applicants have canceled claims 8, 9, 18 and 19.

#### The Prior Art Rejections

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The U.S. Patent and Trademark Office has just recently issued new guidelines for determining obviousness under 35 U.S.C. § 103 in view of the Supreme Court's decision in *KSR Int'l Co. v. Teleflex Inc.* See Federal Register/Vol. 72, No. 195 at 57526. Consistent with past practice, however, the guidelines still require Examiners, when basing rejections on the combination of prior art, to articulate either 1) "a finding that the prior art included each element claimed," see Federal Register/Vol. 72, No. 195 at 57529; or 2) "a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." See Federal Register/Vol. 72, No. 195 at 57534.

#### Claims 1, 12 and 25

The cited prior art fails to disclose or suggest the claimed subject matter. As

discussed above, the subject matter of independent claims is directed to receiving a list of detected wireless network access devices from a wireless client, computing a set of allowable access elements (which may be computed based on load), and then providing to the wireless client the list of wireless network access devices that are both allowable and detected by the wireless client. Accordingly, if the instant association request is denied, the wireless client can attempt an association request with an alternative wireless network access device within range of the wireless client.

The cited prior art fails to disclose or suggest the claimed subject matter. Whelan discloses a wireless network system where a roaming control server provides association lists to wireless clients. However, the association lists are not transmitted in connection with association responses. Rather, in Whelan they are either transmitted during a separate synchronization process over a wired or wireless network or received as information appended to beacon frames. Furthermore, Whelan does not disclose receiving association requests including a list of wireless network access devices detected by the wireless client during the scan. Furthermore, Whelan does not teach a system where the wireless network infrastructure compares the set of allowable wireless network access devices to the set of wireless network access devices detected by the wireless client during a scan. Rather, in Whelan, it is the wireless client that determines which access element to associate with based on a current association list. The association list, however, is not generated from a comparison of allowable network access devices and detected network access devices.

Still further, Kostic fails to disclose or suggest the claimed subject matter. Kostic merely discloses a wireless network where access points transmit beacon frames with load information (such as the number of associations). The wireless clients within range of the beacons select an access point for association based on the received signal strength of the

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beacons and the load information advertised by the access points in the beacons. Kostic, however, does not disclose the generation of a list of access points that are both allowable (from the standpoint of the network infrastructure) and detected (from the standpoint of the wireless client). In addition, Kostic teaches away from the present invention as it places association decisions with the wireless client, not the network infrastructure. The remaining cited references are not relevant. The Examiner merely relies on Islam for its disclosure a load balancing algorithm, and Hawkins to disclose tunneling technologies. Neither Islam nor Hawkins contain teachings relevant to the subject matter of claims 1, 12, and 25 as described above.

Furthermore, Applicants also point out that claim 31 includes a limitation that the association request "includes a list of one or more wireless network access devices detected in the scanning step." Accordingly, claim 31 is also allowable over the cited references for the same reasons discussed above.

#### Claim 30

The Examiner appears to have rejected claims 30-33 based solely on Kostic. Kostic fails to support these rejections. As discussed above, claim 30 has been amended to state that the wireless client performs the recited subject matter. Furthermore, as discussed above, Kostic merely discloses a wireless client that receives load information from beacons transmitted by access points, and selects an access point based on this load information and, optionally, the received signal strength of the beacons as well. Kostic, however, does not disclose a wireless network where association responses include lists of allowable access points. Kostic also does not disclose a wireless client that select an access point from the list of allowable access points for association. Rather, the wireless client of Kostic would again make association decisions based on load and signal strength

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information associated with received beacon frames.

In light of the foregoing, Applicant believes that all currently pending claims are presently in condition for allowance. Applicant respectfully requests a timely Notice of Allowance be issued in this case. If the Examiner believes that any further action by Applicant is necessary to place this application in condition for allowance, Applicants request a telephone conference with the undersigned at the telephone number set forth below.

Respectfully Submitted,  
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By

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